REMARKS

Claims 10-13 and 15-18 are found allowable subject to being rewritten in independent form. Claim 14 has been amended to include the subject matter of allowable claim 15. Further, claim 2 has been amended to include the subject matter of allowable claim 10. Claims 10 and 15 have been cancelled. Claims 3, 9, 11, 12 and 16 have been amended to make them consistent with the amended claims 2 and 14.

Claims 1-9, 14 and 19 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Murthy et al.

This rejection is respectfully traversed for the following reasons.

Anticipation, under 35 U.S.C. § 102, requires that each element of a claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. *Kalman v. Kimberly-Clark Corp.,* 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983); *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 9 USPQ2d 1920 (Fed. Cir. 1989) *cert. denied,* 110 S.Ct. 154 (1989). The term "anticipation," in the sense of 35 U.S.C. 102, has acquired the accepted definition meaning "the disclosure in the prior art of a thing substantially identical with the claimed invention." *In re Schaumann,* 572 F.2d 312, 197 USPQ 5 (CCPA 1978). The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the Examiner. *In re Fine,* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Thorpe,* 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); *In re Piasecki,* 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). To satisfy this burden, therefore, each and every element of the claimed invention must be shown by the Examiner to be disclosed in Murthy et al.

However, as demonstrated below, the Examiner has failed to satisfy this burden.

Independent claim 1 recites a multiport data communication system for transferring data packets between ports. The data communication system comprises a plurality of ports for receiving and transmitting the data packets, and a decision making engine responsive to received data packets for directing the received data packets to the ports selected for transmission of the received data packets.

The decision making engine includes:

- a plurality of queuing devices corresponding to the plurality of ports for queuing data blocks representing the data packets received by the corresponding ports,

- logic circuitry responsive to the plurality of queuing devices for processing the data blocks in accordance with a prescribed algorithm to determine destination information,

- a forwarding circuit responsive to the logic circuitry for identifying at least one transmit port , and

- a traffic capture mechanism for enabling one port of said plurality of ports to output data transferred via multiple other selected ports of said plurality of ports.

The Examiner did not point out specifically which elements of Murthy correspond to the claimed plurality of queuing devices corresponding to the plurality of ports for queuing data blocks representing the data packets received by the corresponding ports. Instead, the Examiner asserts that a number of Kbytes in the shared memory 39 is reserved or allocated for each port controller for storing the received packets and transmitted packets.

It is respectfully submitted that this assertion does not indicate that the shared memory contains a plurality of queuing devices corresponding to the plurality of ports for queuing data blocks representing the data packets received by the corresponding ports, as claim 1 requires.

Hence, the reference does not expressly disclose the claimed limitation.

In the event the Examiner relied upon inherency without expressly indicating such reliance, the Examiner should be aware that inherency requires <u>certainty</u>, not speculation. *In re Rijckaert*, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probability or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Examiner provided no factual basis upon which to conclude that the shared memory contains a plurality of queuing devices corresponding to the plurality of ports for queuing data blocks representing the data packets received by the corresponding ports, as claim 1 requires.

Moreover, the reference discloses that packets in the shared memory are not moved (col. 11, line 6). Hence, Murthy et al. does not disclose queuing data blocks representing the data packets received by the corresponding ports. Instead, the reference suggests an indirect approach to handling data using packet descriptors.

Hence, Murthy neither expressly nor inherently discloses a plurality of queuing devices corresponding to the plurality of ports for queuing data blocks representing the data packets received by the corresponding ports, as claim 1 recites.

Moreover, the reference does not disclose the claimed logic circuitry **responsive to the plurality of queuing devices for processing the data blocks** in accordance with a prescribed algorithm to determine destination information
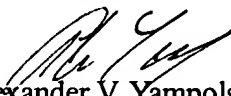
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Accordingly, it cannot be said that Murthy et al. describes the invention recited in claim 1 within the meaning of 35 U.S.C. § 102. *Kalman v. Kimberly-Clark Corp., supra.*

In view of the foregoing, and in summary, claims 1-9, 11-14 and 16-19 are considered to be in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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